

Appl. Ser. No. 10/070,286

Att. Docket No. 10191/2262

Reply to Office Action of June 30, 2004

REMARKS

Claims 21, 23 and 43 to 45 are canceled without prejudice, claims 49 to 51 are added, and therefore claims 16 to 20, 22, 24 to 42 and 46 to 51 are now pending.

It is respectfully requested that the Examiner acknowledge acceptance of the drawings in the next Office communication.

Applicants thank the Examiner for acknowledging the previously filed IDS and PTO-1449 papers and related references.

It is respectfully requested that the Examiner confirm whether certified copies of the priority documents have been received, since the International Bureau should have provided such copies.

With respect to page four (4) of the Office Action, claims 23, 36 and 37 were objected to, since it was indicated that they contained allowable subject matter.

While the rejections may not be agreed with, to facilitate matters, claim 16 has been rewritten to include the features of claim 23 and claim 21 (since claim 23 depends from claim 21). Both claims 21 and 23 have been canceled without prejudice. Claim 22 has been rewritten to depend from claim 16 (rather than canceled claim 21). As explained below, however, the optional feature of an "external access opening" has been removed and included in new dependent claim 50. Also, the "less than 100%" feature has been removed, and an alternative etching step with a porosity of 100% has been included as an alternative step. The etching step is disclosed at page 5 of the specification. Accordingly, claim 16 as presented is allowable for essentially the reasons previously provided, since these features are in no way disclosed by the references relied upon, and for the reasons provided by the Examiner in the Office Action, namely that the "prior art does not teach or suggest producing a cavity or hollow from the second porous layer".

Also, while the rejections may not be agreed with, to facilitate matters, claim 36 has been rewritten to include the features of claim 21 and claim 16 (since claim 21 depends from claim 16). As explained below, however, the optional feature of an "external access opening" has been removed and included in new dependent claim 51. Also, the "less than 100%" feature has been removed. Accordingly, claim 36 as presented is allowable for essentially the reasons previously provided, as is dependent claim 37, since these features are in no way disclosed by the references relied upon.

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It is therefore respectfully requested that the objections be withdrawn.

With respect to page two (2), claims 16 to 20, 24 to 28 and 43 to 48 were rejected under 35 U.S.C. § 102(b) as anticipated by SeeFeldt et al., U.S. Patent No. 5,834,333.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

While the rejections may not be agreed with, to facilitate matters, claim 16 has been rewritten to include the features of claim 23 and claim 21 (since claim 23 depends from claim 21). Both claims 21 and 23 have been canceled without prejudice. Claims 22 and 27 have been rewritten to depend from claim 16 (rather than canceled claim 21). Accordingly, claim 46 is allowable, as are its dependent claims 17 to 20, and 24 to 28 (as are dependent claims 22, 29 to 35 and 38 to 42).

Also, while the rejections may not be agreed with, to facilitate matters, claim 46 has been rewritten to include features like that of claim 23 and claim 21 (since claim 23 depends

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from claim 21). As explained below, however, the optional feature of an “external access opening” has been removed and included in new dependent claim 49. Also, the “less than 100%” feature has been removed, and an alternative etching with a porosity of 100% has been included as an alternative. Accordingly, claim 49 as presented is allowable for essentially the reasons previously provided, since these features are in no way disclosed by the references relied upon. Claims 47 and 48 depend from claim 46 as presented and are therefore allowable for the same reasons as claim 46 as presented.

Also, as regards the foregoing and to facilitate matters, claims 43 to 45 have been canceled without prejudice.

With respect to page three (3), claims 16 to 22, 24 to 28, 35 and 39 to 48 were rejected under 35 U.S.C. § 103(a) as obvious over the “Seefeldt” reference.

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

Claims 16 to 20, 22, 24 to 28, 35, 39 to 42 and 46 to 48 are allowable for essentially the same reasons explained above as to the anticipation rejections. Claims 21 and 43 to 45 were canceled without prejudice. It is therefore respectfully requested that the obviousness rejections be withdrawn.

With respect to page three (3), claims 16 to 22, 24 to 35, 38 and 40 to 48 were rejected under 35 U.S.C. § 103(a) as obvious over the “Seefeldt” reference in view of “Brendel”, U.S. Published Patent Application No. 2003/0017712 A1.

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)). Thus, the “problem confronted by the inventor

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must be considered in determining whether it would have been obvious to combine the references in order to solve the problem”, Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1998).

Claims 16 to 20, 22, 24 to 35, 38, 40 to 42 and 46 to 48 are allowable for essentially the same reasons explained above as to the anticipation rejections. Claims 21 and 43 to 45 were canceled without prejudice. It is therefore respectfully requested that the obviousness rejections be withdrawn.

Claims 49, 50 and 51 do not add any new matter and are supported in the specification. The features of claims 49-51 were removed from earlier presented claims 16, 36 and 46, since these features were optional in the original German claims. Pages 2 and 22 of the application make plain that the external access opening is only an optional feature. The embodiments of Figures 3-6 as compared to that of Figures 7 and 9, together with the description of the Figures in the specification, also makes plain that the external access opening feature of claims 49-51 is an optional feature. Claims 49, 50 and 51 respectively depend from claims 46, 16 and 36 and are therefore allowable at least for the same reasons as the claims from which they respectively depend.

It is therefore respectfully submitted that all of claims 16 to 20, 22, 24 to 42 and 46 to 51 are allowable.

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CONCLUSION

In view of the foregoing, it is believed that the objections and rejections have been obviated, and that claims 16 to 20, 22, 24 to 42 and 46 to 51 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, and that the present application issue as early as possible.

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Respectfully submitted,

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